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24 UNITED STATES DISTRICT COURT  
25 NORTHERN DISTRICT OF CALIFORNIA  
26 SAN FRANCISCO DIVISION

27 OVERTURE SERVICES, INC., a  
28 Delaware Corporation,

Plaintiff,

vs.

GOOGLE INC., a California Corporation,  
Defendant.

No. C02-01991 JSW (EDL)

**OVERTURE'S REPLY IN SUPPORT OF  
ITS MOTION TO COMPEL GOOGLE'S  
RESPONSE TO INTERROGATORY 10**

## INTRODUCTION

Google provides no legitimate reason why it should not respond to Interrogatory No. 10 at this time. Indeed, Google concedes one of its three objections completely, and the remaining objections lack merit. Accordingly, Google should be required to provide a complete response to Interrogatory 10 at this time.

## ARGUMENT

### I. Google Concedes That Interrogatory 10 is Not Unduly Burdensome

Google's opposition does not even address its objection that Interrogatory No. 10 is unduly burdensome. Accordingly, it seems Google wisely concedes that responding to the interrogatory does not present an undue burden.

### II. Google's Prematurity Argument is Without Merit

Google's prematurity argument is undermined by the very cases that Google cites for support. Google argues that Interrogatory No. 10 is a contention interrogatory, which purportedly should be deferred until the end of discovery. One of the cases Google cites, however, explicitly recognizes that at least part of Interrogatory 10 does not seek contention discovery and therefore may not be deferred. *See B. Braun Med. Inc. v. Abbot Labs.*, 155 F.R.D. 525, 527 (E.D. Penn. 1994) (interrogatory seeking an identification of each claim element or limitation that is absent from the accused system is *not* a contention interrogatory). Thus, Google must at least identify which claim limitations are absent from Google's Sponsored Search System.

The other case Google cites explicitly recognizes that *even some contention interrogatories* are best answered early in the pretrial period because they help to clarify and narrow the disputed issues for discovery. *See In re Convergent Techs. Secs. Litig.*, 108 F.R.D. 328, 337 (N.D. Cal. 1985) (it is unwise to create a rigid rule deferring all contention interrogatories to the end of discovery because some kinds of contention interrogatories can clarify and narrow the issues in litigation *early* in the pretrial period). Interrogatory 10 is a perfect example of an interrogatory that, if answered now, would narrow the issues for further discovery. Given an explanation of the bases for Google's

1 assertion of non-infringement, Overture will be able to focus its discovery efforts on the  
 2 truly disputed issues. This will save Overture significant time and effort reviewing  
 3 Google's voluminous source code. It also will save both parties time and effort in  
 4 preparing for and attending future depositions and exchanging written discovery.

5 Requiring Google to answer Interrogatory 10 at this time also is consistent with  
 6 Rule 11 of the Federal Rules of Civil Procedure. See *O'Connor v. Boeing North Am.,*  
 7 *Inc.*, 185 F.R.D. 272, 281 (C.D. Cal. 1999) (quoting *In re One Bancorp Securities*  
 8 *Litigation*, 134 F.R.D. 4, 8 (D. Me. 1991). As the court in *One Bancorp Securities*  
 9 *Litigation* explained in the context of disputed contention interrogatories:

10 Consistent with Rule 11 of the Federal Rules of Civil  
 11 Procedure, plaintiffs must have had some factual basis for  
 12 the allegations in their complaint. Plaintiffs must answer  
 13 [defendant's] interrogatories with such information as they  
 now possess; furthermore, plaintiffs should supplement their  
 responses to reflect new information developed as their own  
 discovery progresses.

14 *One Bancorp Securities Litigation*, 134 F.R.D. 4, 8 (D. Me. 1991). Likewise, Rule 11  
 15 requires that defendant Google must have had some factual basis for the allegations in  
 16 its answer and counterclaims. Google should be required to answer Interrogatory 10  
 17 with such information as it now possesses, and should supplement that answer to  
 18 reflect new information as discovery progresses.

### 19 **III. Google Has Not Shown That Interrogatory 10 Includes *Discrete* Subparts**

20 Google provides little more than conclusory assertions that Interrogatory No. 10  
 21 improperly includes multiple discrete subparts. First, Google asserts that Interrogatory  
 22 10 is compound because it requires Google to explain its noninfringement position for  
 23 all 67 patent claims. Google does not dispute, however, that these alleged "subparts"  
 24 are both "logically and factually subsumed within and necessarily related to the primary  
 25 question," that is, why Google believes it does not infringe the '361 patent. See *Kendall*  
 26 *v. GES Exposition Servs., Inc.*, 174 F.R.D. 684, 685 (D. Nev. 1997). Rather, Google  
 27 attempts to confuse the issue by basing its arguments on hypothetical interrogatories  
 28 that cover *all* contentions or *all* defenses. Such interrogatories are not at issue here.

1 The interrogatory at issue covers one specific allegation—Google’s allegation that it  
 2 does not infringe the ’361 patent. Overture is entitled to an explanation of Google’s  
 3 bases for this allegation, and Overture should not be required to serve “dozens” of  
 4 separate interrogatories to get a complete explanation.

5 Second, Google distinguishes between literal infringement and infringement  
 6 under the doctrine of equivalents, arguing that each of these components constitutes a  
 7 discrete subpart. Although literal infringement and infringement under the doctrine of  
 8 equivalents also are part of the *common non-infringement theme*, and therefore  
 9 constitute a single question for purposes of Rule 33(a),<sup>1</sup> this prong of Google’s  
 10 argument is hardly worth debating. If it will bring closure to this dispute, Overture is  
 11 willing to count Google’s explanation of literal non-infringement and non-infringement  
 12 under the doctrine of equivalents as two separate interrogatories. Each of these  
 13 responses, however, should address all 67 of the claims that Google apparently alleges  
 14 it does not infringe.

### 15 CONCLUSION

16 For the reasons set forth in Overture’s motion and in this reply, Overture  
 17 respectfully requests that the Court order Google to provide a complete response to  
 18 Interrogatory No. 10 at this time.

19  
 20 Dated: December 23, 2003

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28 <sup>1</sup> See *id.*, 181 F.R.D. at 444 (quoting 8A CHARLES A. WRIGHT, ARTHUR R. MILLER & RICHARD L. MARCUS, FEDERAL PRACTICE AND PROCEDURE § 2168.1, at 261 (2d ed. 1994)).